

REMARKS

Claims 1 and 29 are amended herein. Claims 1, 2, 4-15, 17-25 and 27-29 remain pending in the application.

35 USC 112 First Paragraph Rejection of Claim 29

The Office Action rejected claim 29 as allegedly containing subject matter which was not described in the specification under 35 USC 112.

In particular, the specification allegedly fails to disclose a switch that is based on receipt of a trigger signal from a base unit of a cordless telephone, with emphasis by the Examiner on the phrase "based on" and "trigger".

Claim 29 is amended herein to clarify the claim language, with support found in the specification at, e.g., page 5, lines 9-24.

It is respectfully submitted that claim 29 is in full conformance with 35 USC 112. It is respectfully requested that the rejection be withdrawn.

Claims 1, 2, 4 and 5 over Borland in view of Rostoker and Rydbeck

In the Office Action, claims 1, 2, 4 and 5 were rejected under 35 U.S.C. § 103(a) as being obvious over Borland, U.S. Patent No. 6,343,217 ("Borland") in view of Rostoker et al., U.S. Patent No. 6,035,212 ("Rostoker"), and further in view of Rydbeck et al., International Publication No. WO 99/43136 ("Rydbeck").

The Applicants respectfully suggest that the need to combine as many as three (3) separate patents to allegedly arrive at the presently recited invention is evidence of the non-obviousness of the present invention.

Claims 1, 2, 4 and 5 recite, *inter alia*, a remote handset of a cordless telephone that can switch between performing as a telephony device and an MPEG audio player.

Borland appears to disclose a digital cordless telephone system using lossless pulse code modulation (PCM) for encoding an audio signal (Abstract). The system uses an uncompressed encoding scheme to reduce costs and improve the quality of implementation (Borland, col. 4, lines 14-52).

Although Borland recognizes various compression schemes within the digital cordless telephone art within the background of the invention, none of which are MPEG (Borland, col. 3, line 64 – col. 4, line 2). A central focus of Borland's invention is to NOT use compression (Borland, col. 4, lines 14-16). Borland teaches away from using any type of compression within a cordless telephone to save cost. Borland fails to disclose or suggest a remote handset of a cordless telephone that can switch between performing as a telephony device and an MPEG audio player, as recited by claims 1, 2, 4 and 5.

The Office Action correctly acknowledged that Borland fails to disclose an MPEG audio player integrated within at least one of a remote handset and a base unit, a central focus of the Applicants' invention (Office Action, page 3). However, the Office Action relies on Rostoker to allegedly make up for the deficiencies in Borland to arrive at the recited invention. The Applicants respectfully disagree.

Rostoker appears to disclose a wireless communication device that may take the form of a cellular telephone, a portable communication device or a personal computer that can communicate over a cellular network (Abstract). The wireless communication device is configured to self adapt to various operating frequencies and communication protocols (Rostoker, Abstract). The wireless communication device is able to recognize various compression schemes including motion picture experts group (MPEG), MPEG1, MPEG2 and MPEG4 video compressions (Rostoker, col. 13, line 60 – col. 14, line 10).

Rostoker relates to a cellular telephone communicating with a cellular network. A cellular telephone receives a call signal from a cellular relay tower. A cellular telephone receiving a call signal from a cellular relay tower is NOT a remote handset of a cordless telephone, much less one that can switch between performing as a telephony device and an MPEG audio player, as recited by claims 1, 2, 4 and 5.

The Office Action correctly acknowledged that the combination of Borland and Rostoker fail to disclose a remote handset that can switch between performing as a telephony device and performing as an audio player (Office Action, page 4). However, the Office Action relies on Rydbeck to allegedly make

up for the deficiencies in the combination of Borland and Rostoker to arrive at the recited invention. The Applicants respectfully disagree.

Rydbeck appears to disclose a cellular telephone that includes an internally integrated digital entertainment module (Abstract). Audio is played back through a headset while a user engages in leisure activities and automatically mutes or stops playback of the audio until a call is terminated (Rydbeck, page 7, lines 4-8).

Rydbeck discloses a cellular telephone that switches between playing audio and performing a telephony function. A cellular telephone receives a call signal from a cellular relay tower. A cellular telephone is NOT a remote handset of a cordless telephone, much less one that can switch between performing as a telephony device and an MPEG audio player upon receipt of a trigger signal, as recited by claims 1, 2, 4 and 5.

Neither Borland, Rostoker nor Rydbeck, either alone or in combination, disclose, teach or suggest a remote handset of a cordless telephone that can switch between performing as a telephony device and an MPEG audio player, as recited by claims 1, 2, 4 and 5.

The Examiner alleges that modifying Borland's remote handset of a cordless telephone, with Rostoker's cellular telephone having audio player capability, and Rybeck's cellular telephone that switches between playing audio and performing a telephony function arrives at Applicants' remote handset of a cordless telephone that can switch between performing as a telephony device and an MPEG audio player (Office Action, page 9). The Applicants respectfully disagree.

Rostoker and Rybeck's respective inventions are within the cellular telephone art. Neither Borland, Rostoker nor Rybeck provide any motivation of application Rostoker or Rydbeck outside of the cellular telephone art, much less application to a cordless telephone, which although both performing telephony functions, use incompatible components to do so over differing networks.

Moreover, the Examiner is using improper hindsight to modify Borland to allegedly arrive at the claimed invention. Neither Borland, Rostoker nor Rydbeck suggest modifying a cordless telephone to play MPEG audio, much

less switching between performing as a telephony device and an MPEG audio player. Recognizing a fact from the present application, without suggestion thereof by the prior art is an indication of hindsight consideration. Simplicity and hindsight are not proper criteria for resolving obviousness. In re Warner, 379 F. 2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, for at least all the above reasons, claims 1, 2, 4 and 5 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Claims 6, 7, 11, 13-15, 17, 18, 21, 23-25, 27 and 28 over Borland in view of Rostoker and Razavi**

In the Office Action, claims 6, 7, 11, 13-15, 17, 18, 21, 23-25, 27 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Borland in view of Rostoker, and further in view of Razavi et al., U.S. Patent No. 6,253,122 ("Razavi"). The Applicants respectfully traverse the rejection.

The Applicants respectfully suggest that the need to combine as many as three (3) separate patents to allegedly arrive at the presently recited invention is evidence of the non-obviousness of the present invention.

Claims 6, 7, 11, 13-15 and 17 recite, *inter alia*, playing MP3 music from a remote handset of a cordless telephone connected to a PSTN. Claims 18, 21, 23-25, 27 and 28 recite, *inter alia*, playing pre-loaded MP3 music from a remote handset of a cordless telephone connected to a PSTN.

As discussed above, neither Borland nor Rostoker, either alone or in combination, disclose, teach or suggest an MPEG audio player integrated within a remote handset of a cordless telephone, as recited by claims 6, 7, 11, 13-15, 17, 18, 21, 23-25, 27 and 28.

The Office Action relies on Razavi to allegedly make up for the deficiencies in Borland and Rostoker to arrive at the recited invention. The Applicants respectfully disagree.

Razavi appears to disclose a dashboard for a vehicle comprising a monitor which displays graphical images depicting dashboard instruments (Abstract). A user may request that music in MP3 format be downloaded for a

passenger's entertainment (Razavi, col. 15, lines 13-15).

Razavi's MP3 music is downloaded to a vehicle system. A vehicle system is NOT a telephony system, much less a remote handset of a cordless telephone, as recited by claims 6, 7, 11, 13-15, 17, 18, 21, 23-25, 27 and 28.

Neither Borland, Rostoker nor Razavi, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone, as recited by claims 6, 7, 11, 13-15, 17, 18, 21, 23-25, 27 and 28.

The Examiner alleges that Razavi discloses playing pre-loaded MP3 music, and it would have been obvious to combine Razavi, Borland and Rostoker to arrive at the claimed invention (Office Action, page 10). The Applicants respectfully disagree.

As discussed above, Razavi discloses application to a vehicle system. Razavi fails to disclose or suggest application of his teachings to a cordless telephone. Recognizing a fact from the present application, without suggestion thereof by the prior art is an indication of hindsight consideration. Simplicity and hindsight are not proper criteria for resolving obviousness. In re Warner, 379 F. 2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, for at least all the above reasons, claims 6, 7, 11, 13-15, 17, 18, 21, 23-25, 27 and 28 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

#### Claim 8 over Borland, Rostoker, Razavi and Sitnik

In the Office Action, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Borland in view of Rostoker and Razavi, and further in view of Sitnik, U.S. Patent No. 6,300,880 ("Sitnik"). The Applicants respectfully traverse the rejection.

The Applicants respectfully suggest that the need to combine as many as four (4) separate patents to allegedly arrive at the presently recited invention is evidence of the non-obviousness of the present invention.

Claim 8 is dependent on claim 6, and is allowable for at least the same reasons as claim 6.

Claim 8 recites, *inter alia*, playing MP3 music from a remote handset of a cordless telephone connected to a PSTN.

As discussed above, neither Borland, Rostoker nor Razavi, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone connected to a PSTN, as recited by claim 8.

The Office Action relies on Sitnik to allegedly make up for the deficiencies in Borland, Rostoker and Razavi to arrive at the recited invention. The Applicants respectfully disagree.

Sitnik appears to disclose a multichannel switched communication system having a plurality of communication channels (Abstract). A plurality of mobile receivers, i.e., headphones, each receive a desired broadcast on one of a plurality of channels (Sitnik, Abstract). The music is played in real time as it is received by receivers (Sitnik, col. 11, lines 25-29).

Playing a broadcast on a headphone is NOT playing MP3 music on a cordless telephone, much less playing MP3 music from a remote handset of a cordless telephone connected to a PSTN, as recited by claim 8.

Neither Borland, Rostoker, Razavi nor Sitnik, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone connected to a PSTN, as recited by claim 8.

Accordingly, for at least all the above reasons, claim 8 is patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Claims 9, 10, 19 and 20 over Borland, Rostoker, Razavi and Wingate**

In the Office Action, claims 9, 10, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Borland in view of Rostoker and Razavi, and further in view of Wingate, U.S. Patent No. 6,006,115 ("Wingate"). The Applicants respectfully traverse the rejection.

The Applicants respectfully suggest that the need to combine as many as four (4) separate patents to allegedly arrive at the presently recited invention is evidence of the non-obviousness of the present invention.

Claims 9, 10, 19 and 20 are dependent on claims 6 and 18 respectively, and are allowable for at least the same reasons as claims 6 and 18.

Claims 9, 10, 19 and 20 recite, *inter alia*, playing MP3 music from a remote handset of a cordless telephone.

As discussed above, neither Borland, Rostoker nor Razavi, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone, as recited by claims 9, 10, 19 and 20.

The Office Action relies on Wingate to allegedly make up for the deficiencies in Borland, Rostoker and Razavi to arrive at the recited invention. The Applicants respectfully disagree.

Wingate appears to disclose wireless headphones that receive radio frequency transmissions from a sound system to provide music to a user (Abstract). A telephone base unit broadcasts notification of incoming phone calls to the wireless headphones (Wingate, Abstract).

Wingate's playing music from a headphone is NOT playing music from a remote handset of a cordless telephone, much less playing MP3 music from a remote handset of a cordless telephone, as recited by claims 9, 10, 19 and 20.

Neither Borland, Rostoker, Razavi nor Wingate, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone, as recited by claims 9, 10, 19 and 20.

The Examiner alleges that Borland, Rostoker and Razavi as modified by Wingate playing music arrives at the claimed invention. The Applicants respectfully disagree.

The general proposition of "playing music" is disclosed by an enormous number of references, patents and non-patents. However, Wingate's general proposition of "playing music" is specifically applied to a headphone, with no suggestion of application to any type of telephony device, much less to a cordless telephone.

Moreover, the Examiner is using improper hindsight to modify Borland, Rostoker and Razavi to allegedly arrive at the claimed invention. Neither Borland, Rostoker nor Razavi suggest modifying a cordless telephone to

play MP3 music. Recognizing a fact from the present application, without suggestion thereof by the prior art is an indication of hindsight consideration. Simplicity and hindsight are not proper criteria for resolving obviousness. In re Warner, 379 F. 2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, for at least all the above reasons, claims 9, 10, 19 and 20 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Claims 12 and 22 over Borland, Rostoker, Razavi and Bartlett**

In the Office Action, claims 12 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Borland in view of Rostoker and Razavi, and further in view of Bartlett, U.S. Patent No. 5,519,762 ("Bartlett"). The Applicants respectfully traverse the rejection.

The Applicants respectfully suggest that the need to combine as many as four (4) separate patents to allegedly arrive at the presently recited invention is evidence of the non-obviousness of the present invention.

Claims 12 and 22 are dependent on claims 6 and 18 respectively, and are allowable for at least the same reasons as claims 6 and 18.

Claims 12 and 22 recite, *inter alia*, playing MP3 music from a remote handset of a cordless telephone.

The Examiner alleges that Borland, Rostoker and Razavi modified with Bartlett results in playing MP3 music from a remote handset of a cordless telephone connected to a PSTN (Office Action, page 11). The Applicants respectfully disagree.

As discussed above, neither Borland, Rostoker nor Razavi, either alone or in combination, disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone, as recited by claims 12 and 22.

The Office Action relies on Bartlett to allegedly make up for the deficiencies in Borland, Rostoker and Razavi to arrive at the recited invention. The Applicants respectfully disagree.

Bartlett appears to disclose a cordless telephone that provides for improved conservation of battery power in a handset unit (Abstract).

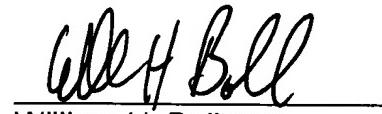
Bartlett fails to even mention MP3 music, much less playing MP3 music from a remote handset of a cordless telephone, as recited by claims 12 and 22. Thus, even the combination of the FOUR references Borland, Rostoker, Razavi and Bartlett fail to disclose, teach or suggest playing MP3 music from a remote handset of a cordless telephone, as recited by claims 12 and 22.

Accordingly, for at least all the above reasons, claims 12 and 22 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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